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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,459	09/13/2000	Morikatsu Matsuda	000004.000661	2151

27557 7590 12/14/2005

BLANK ROME LLP  
600 NEW HAMPSHIRE AVENUE, N.W.  
WASHINGTON, DC 20037

EXAMINER
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GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/661,459

**Applicant(s)**

MATSUDA ET AL.

**Examiner**

Charles Goodman

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Amendment filed on July 25, 2005 has been entered.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 25, 2005 has been entered.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Klingel (US 4,583,719).

Dunn discloses the invention substantially as claimed (note the last Office Action), except for the first positioning device further including a first approaching motor. However, Klingel teaches a machine for stamping, nibbling, etc. comprising a positioning device (e.g. 34, 44) having a drive motor (11) for positioning the workpiece in the X-direction and further including an approaching motor (7) for the purpose of motorize adjustable clamping of workpieces of various widths (see, e.g., Fig. 1) which clearly teach or suggest ease of computer control in facilitating the clamped feeding of the workpieces. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Dunn with the further motor as taught and suggested by Klingel in order to facilitate computerized control of clamping feeding of the workpieces of various widths which inherently minimizes any down time caused by manual adjustment of the same.

Regarding the recitations or limitations stating essentially that one of the clamps is not moved in the second direction (Y), this is deemed to be encompassed, i.e. inherent, in the teachings of Klingel. For example, Klingel does not state anywhere that either the clamps (e.g. 19 or 35) must be moved together. In fact it appears to be more on point to glean from the teachings of Klingel that either of the clamps may be moved together or individually in the second direction since each clamp assembly has a separate motor to facilitate such movement. Thus, during operation, it is not necessary to move both of the clamps in the Y direction to effect the clamping process. Therefore, to the extent that, e.g., claim 14 states "wherein the second clamp (53A, 53B) is not

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moved in the second direction”, this is deemed to be encompassed in the modified device of Dunn in which the decision to keep one of the two clamps stationary with respect to the other is an obvious matter of design or operational choice of the operator.

### ***Response to Arguments***

6. Applicant's arguments filed July 25, 2005 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that the modified device of Dunn does not render the claims obvious because it allegedly fails to teach, e.g., the first and second positioning devices do not position the workpiece in the second direction, this argument is respectfully traversed. The positioning devices that the Examiner notes in Dunn do not position the workpiece in the second direction contrary to Applicant's arguments. It should be noted that it is the punching head due to the integral nature with the positioning devices which positions the workpiece in the second direction and not the positioning devices themselves. Moreover, while the working environment of Applicant's invention is appreciated, i.e. heavy workpieces in coil form, the coil nature of the work is not claimed and therefore does not require consideration. Furthermore, the nature of the work is not given patentable weight, since it is not claimed and even if so, it has been held that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim, *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969), the inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims, *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935), and the material or article

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worked on by an apparatus does not distinguish the apparatus from prior art which works on a different material or article if the apparatus otherwise is met by the reference, *In re Casey*, 152 USPQ 235 (CCPA 1967). Even if Applicant's assertions are valid to the extent that heavy coil materials would not allow for or are contrary to submit to movement, then it is the Examiner's position that one of ordinary skill in the art would realize that fact and would not operate Dunn's device in that manner.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

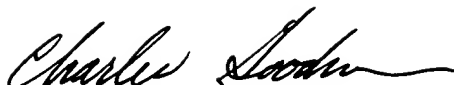
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

cg 

December 12, 2005

**CHARLES GOODMAN**  
**PRIMARY EXAMINER**